

#### IV. AMENDMENTS TO THE DRAWINGS

--- Replacement and annotated mark-up drawing sheets for amended figures showing the amended figures, if any, are attached at the Appendix hereto. Each figure is in compliance with 37 C.F.R. § 1.84. An explanation of the changes, if any, is set forth below in this “Amendments to the Drawings” section. Replacement drawing sheets are identified in the top margin as “Replacement Sheet.” Any replacement drawing sheet including amended figures includes all of the figures appearing on the immediate prior version of the sheet. Any annotated drawing sheets, if the same are required by the Examiner, are identified in the top margin as “Annotated Marked-Up Drawings.” Any deleted figure is noted by an instruction to delete the figure. Any corresponding amendment to the specification necessary to be made because of an amendment to the drawings in this section is made in the corresponding “Amendments to Specification” section.

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:
  - *No Amendment Made to the Drawings*
  - *Attachments: None*

## V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 2 - 6 remain pending in this application. Claims 2 – 6 have been amended herein.

- OBJECTIONS

- OBJECTIONS TO CLAIMS, SPECIFICATION & DRAWINGS

- Examiner's Stance

The Examiner has raised no objections to the claims, specification or drawings.

- Applicants' Response

N/A

- REJECTIONS

- REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

- Examiner's Stance

The Examiner has rejected claims 2 – 6 under 35 U.S.C. §112, second paragraph as “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention” (section 3, page 2, of the Office Action). The Examiner argues that “Phenothiazine5-ium tetraiodide hydrate” in claim 4 should read – Phenothiazine-5-ium tetraiodide hydrate --. He further argues that after “push-pull” the phrase “,which provides the copy protection and prevents readout from the recording layer,” should be added to clearly indicate that the recited compounds “are part of the copy protection as well as their exact function” (section 3, page 2, of the Office Action).

- Applicants' Response

Applicants respectfully traverse the rejection of claims 2 - 6 based in part on the argument that one of ordinary skill in the art would understand the claims to particularly point out and distinctly claim the subject matter being sought in such embodiments. However, Applicants assert that the Examiner's 35 U.S.C. §112, paragraph 2, rejection of claim 4 is mooted by the making of the amendment suggested by the Examiner. In respect of claim 3, the Applicants assert that their amendments thereto obviate the Examiner's 35 U.S.C. §112, paragraph 2, thereto. Applicants no longer recite to the "push-pull" activity, and asserts that the recitation of function in such a claim adds nothing to the patentability of the claim which is patentable without such recitation.

- REJECTIONS UNDER 35 U.S.C. §103

- Examiner's Stance

The Examiner has rejected claims 2 – 6 under 35 U.S.C. §103 on the basis the claimed embodiments are obvious in light of certain art of record.

With respect to claims 2 – 6 the Examiner asserts such claims are unpatentable over U.S. Patent Publication No. 2004/0004922 to Selinfreund *et al.* The Examiner maintains that such reference teaches the use of "various dyes" to provide copy protection of optical media, and that among these dyes are phenothiazine compounds. The Examiner asserts that "[i]t would have been obvious to one skilled in the art to use one of the disclosed compounds, such as those disclosed in sections 0083 – 00104 [of the Selinfreund *et al.* 2004/004922 reference] in place of those specifically used ... with a reasonable expectation of forming a useful copy protected optical medium" (section 5, page 3, of the Office Action).

The Examiner further rejects claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over either of U.S. Patent No. 6,011,772 to Rollhaus *et al.* or U.S. Patent No. 5,815,484 to Smith *et al.* in view of Strekowski *et al.*, "A synthetic route to 3-dialkylamino)phenothiazin-5 -ium salts ...," J. Heterocyclic Chem., Vol. 30(6) pp. 1693 – 1695 (1993). The Examiner maintains that U.S. Patent No. 6,011,772 to Rollhaus *et al.* teaches the use of methylene blue in copy protection, while U.S. Patent No. 5,815,484 to Smith *et al.* teaches the use of various phenothiazines including methylene blue and toluidine blue O in copy protection. He reasons that as the Strekowski *et al.* reference teaches dyes

such as phenothiazin-5-ium tetraiodide hydrate and 3-(dimethylamino)phenothiazin-5-ium triiodide as “good dyes,” “one skilled in the art “ would think it obvious to “to modify the optical recording media of either Rollhaus *et al.* ‘772 or Smith *et al.* ‘484 by using other, similar, phenothiazin-5-ium compounds known to act [sic] as dyes, such as phenothiazin-5-ium tetraiodide hydrate or 3-(dimethylamino)phenothiazin-5-ium triiodide disclosed by Strekowski *et al.* ... with a reasonable expectation of forming a useful copy protected optical recording medium which protects optical recording media based upon the oxidation of the phenothiazine by oxygen in air” (section 6, pages 3 – 4, of the Office Action).

- Applicants’ Response

Applicants respectfully traverse the rejection of claims 2- 6 under 35 U.S.C. §103(a) based in part on the argument that the Examiner has provided inadequate motivation for the combination of references in the manner indicated by the Examiner, and because the Examiner’s argument boils down to simply an “obvious-to-try” assertion without support for his assertions of a “reasonable expectation” of success in the attempt.

With respect to U.S. Patent Publication No. 2004/0004922 to Selinfreund *et al.*, Applicants note no specific teaching of the compounds being presently asserted in the sole independent claim, i.e. claim 3. Nor does it teach that such compounds in proper formulations associated with the disc could undergo an optical state change at wavelengths from about 770 nm to about 830 nm. Such information is simply not there. Obviousness is judged by one of ordinary skill in the art. As one of ordinary skill in the art would understand, there are a myriad of parameters that may effect the change in optical state of a material, and the wavelengths at which such changes occur. The Examiner has simply provided no rational reason why the particular compounds recited would cause such a change within the wavelengths recited when placed in conjunction with a disc, rather than, for example, being in an aqueous or other solvent mixture. Much of our need for chemists results from our lack of understanding of all of the parameters affecting reactivity and properties. Respectfully, the Examiner’s statements of obviousness are simply belied by the real world fact of the rampant use of trial and error in the chemical field. It is simply not obvious to anyone of ordinary skill in the art that the recited compounds would work to cause such an effect on a optical disc, and if the Examiner’s mode of reasoning is correct, there would be much less need for chemists in the art.

With respect to claims 4 and 5, Applicants note that such claims have been amended to depend from claim 3, and therefore are asserted to be non-obvious for at least the reason recited with respect to this claim. Furthermore, neither U.S. Patent No. 6,011,772 to Rollhaus *et al.* nor U.S. Patent No. 5,815,484 to Smith *et al.* in view of Strekowski *et al.*, “A synthetic route to 3-dialkylamino)phenothiazin-5 –ium salts ...,” J. Heterocyclic Chem., Vol. 30(6) pp. 1693 – 1695 (1993) or otherwise, make obvious these claims. The combination of these references is simply motivated by a desire of the Examiner to find disclosure of the claimed materials, and then to wed them to a copy-protected optical disc by sleight of hand. There is simply no reason one would reach out to the particular compounds referenced by the Examiner to be in of Strekowski *et al.*, “A synthetic route to 3-dialkylamino)phenothiazin-5 –ium salts ...,” J. Heterocyclic Chem., Vol. 30(6) pp. 1693 – 1695 (1993) to use on an optical disc to cause an optical state change at wavelengths from about 770 nm to about 830 nm and use the same as a copy protected optical disc. The Examiner’s urging of the same, again, devolves simply to hindsight reasoning.

- REJECTIONS UNDER JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING

- Examiner’s Stance

The Examiner has rejected claims 2 – 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 17 of copending Application no. 10/418898 (U.S. prepub 2004/0004922). The Examiner asserts that “[a]though the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application clearly embrace copy protected optical recording media using the claimed phenothiazines as these are fully encompassed by the claims of the co-pending application as evidenced by sections [0083-0104] of the copending application” (section 8, page 4, of the Office Action). The Examiner recognizes that this rejection is a provisional one, as the conflicting claims “have not in fact been patented.”

- Applicants’ Response

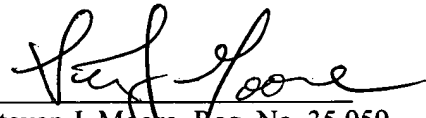
Applicants respectfully traverse the Examiner’s judicially created doctrine of obviousness-type double patenting rejection. Applicants assert that the claims are directed at subject matter which is patentable over the claims recited by the Examiner, as would be

understood by one of ordinary skill in the art. Applicants will file an appropriate terminal disclaimer if the claims herein are found patentable and if the claims truly are not patentably distinct from those in such reference.

CONCLUSION TO REMARKS

Applicants assert that this response is fully responsive to the Examiner's office action dated May 2, 2005 in the filing of the RCE application herewith. Applicants respectfully seek early allowance of the pending claims.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Steve Moore", is written over a horizontal line.

Steven J. Moore, Reg. No. 35,959  
Attorneys for Applicants  
Kelley Drye & Warren LLP  
Two Stamford Plaza  
281 Tresser Boulevard  
Stamford, CT 06901-3229  
[smoore@kelleydrye.com](mailto:smoore@kelleydrye.com)

## **VI. APPENDIX**

- *No appendix is intended to be attached*